

26. (New) A method for producing printed business forms with at least one integrated, removable portion on a press from a source of stock paper in accordance with Claim 15 further comprising the step of receiving the continuous web of paper by at least one punch station prior to the at least one finishing station and removing a selected area of the business form as the continuous web passes through the at least one punch station.

REMARKS

I. INTRODUCTION

Claims 9-14 were present for examination and presently stand rejected. As discussed herein, claims 9-14 have been amended to more particularly and distinctly claim the subject matter Applicant regards as his invention. In addition, new claims 15 and 16 have been added and more particularly and distinctly claim the subject matter Applicant regards as his invention. In addition, the specification has been amended for clarification as discussed herein. Based on the foregoing, and the following remarks, Applicant submits that this application is in condition for allowance. Thus, Applicant respectfully requests reconsideration and allowance of the application as amended. The Appendix hereto contains a version of the foregoing amended claims with brackets and underling to indicate the deletions and additions, respectively.

II. RESPONSE PERTAINING TO THE SPECIFICATION

Initially, although the specification does *not* stand rejected under 35 U.S.C. §112, ¶1, the specification is noted as being "replete with terms which are not clear, concise and exact." The specification and abstract have been amended to correct the instances of "continuous" being misspelled, and the specification has been amended to clarify that the "continuous web" is a continuous web of stock paper and was shown in the drawings already as reference No. 15. These amendments to the specification and abstract do not add new matter.

III. RESPONSE PERTAINING TO REJECTION UNDER 35 U.S.C. §112, ¶2

Claims 10 and 13 stand rejected under 35 U.S.C. §112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the claim term "application" lacks antecedent basis. Consistent with the Examiner's suggestion on page 2 of the Office Action, Claims 10 and 13 have been amended to delete the term "application," and thus, Applicant respectfully submits that this rejection is moot.

Claims 10-11 and 13-14 stand rejected under 35 U.S.C. §112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the "claim as drafted is inaccurate in reciting the receiver station is part of the patch station." Claims 10 and 13 have been amended to delete this subject matter, and thus, applicant respectfully submits that this rejection is moot.

Thus, Claims 10-11 and 13-14 are submitted as being in compliance with 35 U.S.C. §112, ¶2.

IV. RESPONSE PERTAINING TO THE REJECTION OF CLAIMS 9 AND 12 UNDER 35 U.S.C. §102(b)

Claims 9 and 12 stand rejected under 35 U.S.C. §102(b) as being clearly anticipated by U.S. Patent No. 5,656,369 to Chess et al. ("Chess"). Applicant respectfully submits that Chess neither discloses nor suggests the methods of Claims 9 and 12 for a number of reasons.

More specifically, Claim 9 recites "providing a continuous web of stock paper" and "applying adhesive to selected areas of either one or both of the web or patch material to form an adhesive patch with selected areas of the web." In similar fashion, Claim 12 recites "providing a continuous web of stock paper" and "applying adhesive to selected areas of either one or both of the web and patch material with the adhesive patch station." Support for these amendments is found in the specification.

See, e.g., page 2, lines 22-34, and page 4, lines 14-23, page 7, lines 12-17, and original claims 1 and 4 for stock paper and page 4, line 28, through page 5, line 2, and original claims 2 ("applying adhesive to selected areas of said silicone treated backing paper to form said adhesive patch") and 5 ("said applicator applying adhesive to selected areas of said silicone treated paper to from said adhesive patch"). Applicant respectfully reminds the Examiner that it is well-established that the original claims are part of the specification for compliance of 35 U.S.C. § 112. See MPEP § 608.01(1); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 938 (Fed. Cir. 1990) ("the original claims as filed are part of the patent specification.").

Chess discloses neither the aspect of using stock paper nor applying adhesive. As to stock paper, the instant application refers to stock paper as paper that has not been physically converted such as being punched to add line hole punching, prior to being used in the claimed methods. For example, the specifications states:

Second, the costs of manufacturing business forms is reduced because there is no need to perform secondary operations on the stock paper fed into the printing press such as line hole punching. (Page 2, lines 23-24.)

For example, one unique aspect of the present invention is that an adhesive patch can be applied to an integrated stencil, label, or pocket as well as delivering a finished product at the end of the printing press in cut sheet, continuous, or roll form which obviates the need for line-hole punching or any other secondary operations to be performed on the stock paper that is mounted on receiver station 12. (Page 7, lines 12-17.)

Chess does not disclose the use of stock paper. To the contrary, Chess discloses using paper that has been pre-converted, i.e., having line hole punching added prior to being used in the apparatus of Chess. More specifically, in Chess, the line hole punching (referred to in Chess as "removable tractor drive strips") is engaged by "a plurality of powered tractors" used to pull the paper through the machine. (Col. 3, lines 34-37, Col. 4, lines 52-55, FIG. 1 (ref Nos. 16 and 17) and FIG. 3.) Chess discloses using only paper

that has been pre-converted with line hole punching. There is no disclosure of stock paper, *i.e.*, paper that has had no pre-converting work done to it prior to being fed into the apparatus 10.

Further, the claimed methods require the step of applying adhesive. Chess plainly does not disclose this step. To the contrary, Chess discloses using "transfer tape" to carry adhesive. For example, Chess states:

In order to provide a label integral with sheet 11, according to the present invention, conventional transfer tape 19, which is taken off from a tape roll 20, is cut into strips which are then applied, in spaced relationship, to second face 13 of sheet 11. To accomplish this, conventional transfer tape 19—which includes a backing 12, and an adhesive 22 on one face thereof (see FIG. 2)—is taken off of roll 20 with the adhesive face outward. Transfer tape 19 is then fed by a plurality of rollers, including rollers 24 which have the surfaces thereof coated with a release material (such as a silicone-coating) so that adhesive 22 from transfer tape 19 will not adhere thereto, and also guided by other rollers 25, is ultimately fed to a cut-off cylinder 26 cooperating with a vacuum cylinder 27. Cut-off cylinder 26 cuts transfer tape 19 into individual transfer tape strips 29, as seen in FIGS. 1, 2 and 4, which are applied to second face 13 of sheet 11. Second face 13 has a higher affinity for adhesive 22 of transfer tape strips 29 than does backing 21. Virtually all typical bond papers have such affinity.

(Col. 3, lines 39-57.) Chess only discloses using transfer tape, *i.e.*, tape prefabricated to include adhesive. Thus, adhesive is not applied in a separate step in the apparatus 10 of Chess. In other words, the adhesive and patch material in Chess are already combined prior to using the method, and thus, there is no additional step of applying adhesive to either one or both of selected areas of the continuous web and patch material.

In view of the foregoing, Applicant submits that claims 1 and 12 are patentable over Chess under 35 U.S.C. §102(b).

**V. RESPONSE PERTAINING TO THE REJECTION OF CLAIM 10-11 AND 13-14
UNDER 35 U.S.C. §103(a)**

Claims 10-11 and 13-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chess in view of U.S. Patent No. 5,861,457 to Weidner et al. ("Weidner"). Applicant respectfully submits that Chess in view of Weidner neither discloses nor suggests the inventions of Claims 10-11 and 13-14 for a number of reasons.

First, it is initially noted that Claims 10-11 and 13-14 include both the step of providing a continuous web of stock paper and the step of applying adhesive in a step in addition to providing the patch material. Weidner clearly does not disclose or suggest either of these steps. Thus, Claims 10-11 and 13-14 are submitted as being in patentable over Chess in view of Weidner for the reasons discussed above for Claims 9 and 12.

Second, it must be appreciated that in this aspect, the backing paper is the patch material and not the continuous web of stock paper going through the press. In other words, patch material is provided at the adhesive patch station. Thus, Claims 10-11 and 13-14 have been amended to further clarify that the "backing paper" is the "patch material" being provided. Neither Chess nor Weidner disclose or suggest both the steps of providing a supply of patch material and applying adhesive in separate steps at the adhesive patch station.

Third, Claims 11 and 14 are directed to the patch material being glassine paper. Neither Chess nor Weidner disclose or suggest providing patch material that is glassine paper.

In view of the foregoing, Applicant submits that Claims 10-11 and 13-14 are patentable over Chess in view of Weidner under 35 U.S.C. §103(a).

VI. NEW CLAIMS 15 AND 16

Applicant respectfully submits that new Claims 15 and 16 are patentable over Chess and Weidner for the at least the above discussed reasons. Support for these

claims is found in the specification at, for example, page 6, lines 26-29, and page 7, lines 29 through page 8, line 1.

VII. CONCLUSION

Based on the foregoing, Applicant respectfully requests reconsideration and allowance of this application.

Respectfully submitted,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Title: METHOD AND APPARATUS FOR)
PRODUCING MULTIPLE DIE-)
CUT BUSINESS FORMS)

Group)
Art Unit: 2854)

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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on this date.

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APPENDIX

In connection with the above-identified application and the Amendment submitted herewith, Applicant provides this Appendix with portions of the specification, the abstract and the claims marked up to indicate additions and deletions.

IN THE SPECIFICATION:

Page 4, second paragraph:

"A side view of one embodiment of a printing press 10 that is used to manufacture multiple die cut business forms according to [the principle] principles of the invention is shown in Fig. 1. Printing press 10 comprises a number of individual stations that perform specified functions and are connected together by a continuous web so that, for example, multiple die cut business forms may be manufactured in a variety of output configurations directly from a source of stock paper as described in greater detail hereafter."

Page 4, third paragraph:

"Printing press 10 includes a receiver station 12 upon which a source of stock paper is mounted. In the embodiment shown in Fig. 1, the stock paper source comprises a roll 14 of stock paper that is rotatably mounted on receiver section 12 by means of axle 16 to supply a continuous web 15 of paper to the printing press. Printing press 10 is used to manufacture multiple die cut business forms directly from the stock paper roll 14 without the need for any secondary processing such as line-hole punching or separate affixing operations prior to beginning the manufacturing process."

Page 4, fourth paragraph (continuing on to page 5):

"Printing press 10 includes two printing stations 20 and 22 that are connected to the receiver station 12 by means of [a continuous web] the continuous web 15. A die cutting station 18 is connected to the printing stations 20 and 22 by the continuous web 15. Two printing stations 24 and 26 are connected in series by the continuous web 15 to die cutting station 18. The continuous web 15 connects an adhesive strip-patch station 28 to printing station 26. Adhesive strip-patch units suitable for use with the present invention are commercially available from a company called Tamarack (Wauconda, Illinois)."

Page 5, first paragraph:

"Three post adhesive patch die cutting stations 30, 32, and 34 are connected in-line with the adhesive strip-patch station 28 by the [continuos web] continuous web 15 as shown. The [continuos web] continuous web 15 connects a finishing station 36 to the third post adhesive patch die cutting station 34 via punching station 38 as shown in Fig. 1. The various stations 14-34 and 38 perform various operations in a predetermined order so that various types of multiple die cut business forms may be produced in the output configuration specified by finishing station 36 as discussed in greater detail hereafter."

Page 6, second paragraph (continuing on to page 7):

"Referring back to Fig. 2, the adhesive strip-patch unit 28 allows an adhesive patch 46 to be removably affixed to the paper backing from the stock paper roll 14. Unit 28 may be programmed to allow patch 46 to have any desired length and shape. Die cutting units 30, 32, and 34 perform post-adhesive patch/strip operations as needed in accordance with the type of multiple die cut business form being prepared in a particular application as desired and as shown at location 48. Punching station 48 is provided [in the continuous web] along the continuous web 15 from receiver station 12 to finishing station 36 to allow the multiple die cut business forms to be produced by printing press 10 in a given application to have line-hole punching as shown at 50 and 52 or preformations. Figs. 3-5 show additional examples of the die cutting and punching operations that can be performed by die cutting stations 30, 32, and 34 as well as punching station 38. One aspect of finishing unit 36 is to process the multiple die cut business forms produced by printing press 10 in one of three output configurations: output roll form as shown at 54 in Fig. 7, cut sheet form as shown at 56 in Fig. 2, and fan-fold form as shown at 58 in Fig. 8."

Page 7, fourth paragraph (continuing on to page 8):

"Integrated stencils can be manufactured by printing press 10 in [continuous] continuous, cut sheet, or roll form by affixing stencil material in-line while simultaneously printing the form graphics, then die-cutting the back of the stock and removing the die cut material. This also provides the option of forming a label for address identification by die cutting the stencil material and leaving ties so that, for example, a die cut round cornered rectangle remains in the form after direct contact, non-contact, or thermal imaging processing."

Page 9, second paragraph:

"From the foregoing, it will be observed that numerous modifications and variations can be effectuated without departing from the true spirit and scope of the novel concepts of the present invention. It is to be understood that no limitation with respect to the specific embodiments illustrated is intended or should be inferred. The disclosure is intended to [cover] be covered by the appended claims, and all such modifications [as] fall within the scope of the claims."

IN THE ABSTRACT:

"A method and apparatus for manufacturing multiple die cut business forms is disclosed. One embodiment of a printing press according to the present invention includes a number of different stations that are connected together by a [continuos] continuous web. Multiple die cut business forms are produced by a [continuos] continuous process from stock paper to an output configuration such as [continuos] continuous roll, fan fold, or cut sheet. One aspect of the present invention is that a silicone treated glassine stock paper substrate can be utilized to allow business forms to be produced with minimized curling."

IN THE CLAIMS:

9. (Amended) A method for producing multiple die-cut business forms, said method comprising the steps of:

providing a continuous web of stock paper;

extending the web through at least one printing station for printing on selected areas of the web;

extending the web from the at least one printing station through an adhesive patch station for applying adhesive to selected areas of either one or both of the web or patch material to form an adhesive patch [to] with selected areas of the web;
and

extending the web from the adhesive patch station through at least one die cutting station for cutting selected portion of the web with multiple die cuts.

10. (Amended) The method of Claim 9 wherein the adhesive patch station includes a supply of patch material [receiver in which a roll of silicone-treated backing paper is mounted] and an applicator operatively coupled with [receiver, the application applying] the supply of patch material so as to apply adhesive to selected areas of [the silicone paper] either one or both of the web and patch material to [form a] apply patch [to be applied] material to selected areas of the web.

11. (Amended) The method of Claim 10 wherein the [backing paper] patch material comprises glassine paper.

12. (Amended) A method for producing multiple die-cut business forms, said method comprising the steps of:

providing a continuous web of stock paper;

extending the web through at least one printing station;

printing on selected areas of the web with the printing station;

extending the web from the at least one printing station through an adhesive patch station;

applying an adhesive patch to selected areas of the web by applying adhesive to selected areas of either one or both of the web and patch material with the adhesive patch station;

extending the web from the adhesive patch station through at least one die cutting station; and

cutting selected portions of the web contiguous with the adhesive patch with multiple die cuts with the at least one die cutting station.

13. (Amended) The method of Claim 12 wherein the adhesive patch station includes a supply of patch material [receiver in which a roll of silicone-treated backing paper is mounted] and an applicator operatively coupled with [receiver, the application applying] the supply of patch material so as to apply adhesive to selected areas of [the silicone paper] either one or both of the web and patch material to [form a] apply patch [to be applied] material to selected areas of the web.

14. (Amended) The method of Claim 13 wherein the [backing paper] patch material comprises glassine paper.